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Application No. 10/572,994

DOCKET NO: ARZ-024630-US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE OF APPLICATION OF:

NELSON, LLOYD A. ET AL.

SERIAL NO: 10/572,994

THIS APPLICATION IS A US NATIONAL
STAGE APPLICATION OF
PCT/US02/12961:

INTERNATIONAL FILING DATE: APRIL 25, 2002 : PRIORITY DATE: APRIL 27, 2001

FOR: POLY BASIC ACID ESTERS AND
THEIR USE IN FIBRE OPTIC CABLES

RESPONSE TO NOTICE OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 AND
PETITION UNDER 37 C.F.R. 1.47(a) FOR FILING WHEN INVENTORS REFUSE TO
SIGN OR CAN NOT BE FOUND

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Notice of Missing Requirements dated May 10, 2006, and prior to examination on the merits, Applicants respectfully submit the following comments, payment of claim fees, payment of petition fees, payment of extension fees, authorization to charge Applicants' deposit account for any fees required to date, and Petition in Response thereof regarding the inventor known as Nancy D. Mosby's refusal to join in the application, along with the attached signed Declaration for the inventor known as Lloyd A. Nelson. Further, Applicants submit the following documents as Exhibits in support of Applicants Petition.

Application No. 10/572,994

Exhibit A: A properly executed Declaration containing the signature of Lloyd A. Nelson and the last known contact information of Nancy D. Mosby (which is derived from Exhibit B below).

Exhibit B: A copy of a properly executed Assignment of U.S. provisional application from which the present application claims ultimate priority from both Lloyd A. Nelson and Nancy D. Mosby.

Exhibit C: A copy of a properly executed Employment Agreement between Union Camp Corporation and Nancy D. Mosby.

Exhibit D: A copy of a Certificate of Merger of Union Camp Corporation into International Paper Company.

Exhibit E: A copy of a signed letter from Nancy D. Mosby to International Paper Company instructing International Paper Company of her refusal to join in the present application.

A duplicate copy of this Response and Petition is filed herewith for the Office's convenience.

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REMARKS

The outstanding Notice Dated May 10, 2006, requires the following in order to satisfy all of the requirements under 35 U.S.C. 371:

- 1) Additional Claim fees of \$1410;
- 2) Oath or declaration of the inventors; and
- 3) A surcharge for the late filing of an oath.

Regarding 1) and 3), Applicants authorize the Office to Charge the \$1410.00 in additional claim fees to our Deposit Account No. 09-0525. Still further, Applicants authorize the Office to charge the \$130.00 for the surcharge for a late submission of the filing fee search fee examination fee, of oath or declaration to our Deposit Account No. 09-0525. Accordingly, Applicants respectfully submit that requirements 1) and 3) are now satisfied; and, respectfully request the Office to indicate the same.

Regarding 2) the Oath or declaration of the inventors, Applicants respectfully submit the attached Exhibit A which is a properly executed Declaration containing the signature of Lloyd A. Nelson and the last known contact information of Nancy D. Mosby (which is derived from Exhibit B below). Unfortunately, in order to satisfy all of requirements related to the oath, Applicants must timely file a Petition herewith under 37 C.F.R. 1.47(a) for filing when inventors refuse to sign or can not be found. In the present application, the inventor known as Nancy D. Mosby has refused to sign and participate in the prosecution of the present application. Accordingly, a petition under 37 C.F.R. 1.47(a) follows.

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PETITION UNDER 37 C.F.R. 1.47(a) FOR FILING WHEN INVENTORS REFUSE TO
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Applicants submit this petition under 37 C.F.R. 1.47(a) for filing when inventors refuse to sign or can not be found in the above-mentioned application. The facts surrounding the request are as follows:

- I) The present application is a United States National Stage of PCT/US02/12961 filed 25 April 2002, having a priority date of 27 April 2001, from United States Provisional Patent Application Number 60/286,880.
- II) United States Provisional Patent Application Number 60/286,880; PCT/US02/12961; and the present application all name two inventors: Lloyd A. Nelson and Nancy D. Mosby.
- III) A Notice to File Missing Requirements was mailed May 10, 2006, requiring submission of an executed oath or declaration
- IV) Lloyd A. Nelson properly executed a declaration which is attached as Exhibit A and submitted to be accepted by the Office.
- V) Both individuals properly executed an assignment (see attached Exhibit B) of all technology related to United States Provisional Patent Application Number 60/286,880 and applications claiming priority thereto.
- VI) Nancy D. Mosby was an employee of Union Camp Corporation as shown by the attached employment contract between Nancy D. Mosby and Union Camp Corporation (see Exhibit C).

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- VII) Union Camp Corporation merged with International Paper Company as demonstrated by the attached Certificate of Merger of Union Camp Corporation into International Paper Company (see Exhibit D).
- VIII) International Paper incorporated Union Camp Corporation's capital and human resources, in part, into a wholly owned subsidiary known as Arizona Chemical Company. Accordingly, both individuals, including Nancy D. Mosby, immediately became employees of International Paper Company indirectly through Arizona Chemical Company.
- IX) At some point in time after the Merger of Union Camp Corporation into International Paper Company, Nancy D. Mosby no longer was an employee of Arizona Chemical Company.
- X) When reasonable efforts were made by Arizona Chemical Company and/or International Paper Company to contact Nancy D. Mosby regarding her participation in any of the present applications, including the present United States National Stage of PCT/US02/12961 filed 25 April 2002, Nancy D. Mosby wrote the attached letter to Arizona Chemical Company and International Paper Company (see Exhibit E) informing Arizona Chemical Company and International Paper Company that she will not participate in the patent prosecution process, including the present United States National Stage of PCT/US02/12961 filed 25 April 2002.
- XI) Executed declarations have not been obtained from inventor Nancy D. Mosby.

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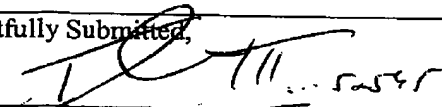
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XII) It is further requested that, in light of the above, the filing requirement be considered complete and the application proceed to examination.

XIII) Please charge the amount of \$1590.00 required for the request for extension of time to our Deposit Account No. 09-0525. Further, please charge the petition fee under 37 CFR 1.17(g) of \$200.00 to our Deposit Account No. 09-0525. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 09-0525. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

XIV) If there are any questions concerning any of the above, please feel free to contact the undersigned.

| | | |
|---|---|--------|
| Correspondence Client Number: 01726 (513) 248-6736 (phone) (513) 248-6445 (fax) | Respectfully Submitted,  | |
| | Thomas W. Barnes III, Ph.D. | |
| | Registration No. | 52,595 |
| | | |

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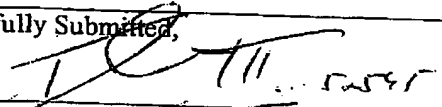
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| Correspondence Client Number: 01726 (513) 248-6736 (phone) (513) 248-6445 (fax) | Respectfully Submitted,  | |
| | Thomas W. Barnes III, Ph.D. | |
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